

## REMARKS

Claims 1-16, 18, 19, 21-23, 26-31, 36, 43-49, 67, 69-70, 72, 74 and 75 are currently pending. Claims 68, 71, 73 and 76 are withdrawn with traverse. Claims 28, 43 and 67 are canceled without prejudice for later renewal. Claims 1, 5, 12, 26, 29, 36, 44, 48 and 74 are amended as set forth above. The amendments are believed to be supported in the Specification as filed.

Rejection of claim 74 under 35 U.S.C. §112 second paragraph.

The Applicants has amended the claim for clarify the vagueness of the claim.

Rejection of claims 1-4 under 35 U.S.C. §102 over U.S. Patent No. 5,658,312 (Green et al.)

Claim 1 as currently amended requires the needle to be substantially longer than the pin. The needle (124) in Green et al. does not have such length in comparison with the pin (121). Furthermore, the two prongs (503) in Green as inserted in the tissues are basically parallel to each other. They are not, nor there is necessity for them to be, capable of bending over the backspan (110) as the pin and flange in the present invention are required to be with regard to the base in the present invention. Therefore, the rejection should be withdrawn. Since claim 2 depends from claim 1, the rejection should be withdrawn as well.

With regard to claim 3, it is well established legal principle that the "means plus function" language falling under 35 U.S.C. §112 ¶6 should be interpreted in view of the corresponding structure in the specification. Once the Examiner takes this into account, it should be clear that claim 3 is not anticipated since Green discloses no structure which may be viewed as a "flange means" "having at least one substantially planar surface for cooperating with the planar surface of the base means." The counterpart for flange in Green designated by the Examiner is a cylindrical shaft (121). Applicants fail to understand how a cylindrical surface can

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be characterized as "substantial planar" and respectfully request the withdrawal of the rejection to claim 3 and claim 4 depending upon it.

Rejection of claims 29-31, 36, 69-70, 72 under 35 U.S.C. §102 over U.S. Patent No.  
5,304,204 (Bregen)

With regard to claim 29 as currently amended, it requires a needle which is substantially longer than the pin. In Bregen, the needle (110) is not substantially longer than the pin (108). Furthermore, there needs to be two needles in order for the Bregen fastener to be inserted into the tissue.

Finally, the needle in the Bregen fastener is normally closed with their opposing ends approach to each other closely. They are "opened up" in a second stage by an instrument in order to penetrate into the tissue at a right angle, and thereafter, resiliently returned to the normal "close" position after being release by the instrument. In contrast, during the first positions of the pin and the base of the present invention, they are spaced apart sufficiently to receive the tissues in between. Only in their second position are the pin and base "closed up" to line in contact with the tissues. Thus, the "open" and "close" procedures in Bregen (which is close - open - close) is almost reversed as to the present invention (which is open - close).

With regard to claim 31, it requires a "single needle" for the surgical staple system. This distinguishes it from Bregen as discussed above.

With regard to claim 36 as currently amended, it requires a "single needle" and the deformation of the first and second sections are different from that in Bregen as discussed above.

In light of the above discussed differences, the present invention does not read upon Bregen. Withdrawal of the rejection to claims 29, 31, 36, as well as dependent claims 30 depending upon claim 29, and claims 69-70, 72 depending upon claim 31 is respectfully requested.

Rejection of claims 26-28, 74-75 under 35 U.S.C. §102 over U.S. Patent No. 4,719,917  
(Barrows et al.)

With regard to claim 26 as currently amended, the first member has a needle substantially longer than such first member. On the contrary, the piercing "leg portion" of the Barrows staple is not substantially longer than the "central portion" of the staple. Therefore, rejection to claim 26, as well as rejection to claim 27 depending upon 26 should be withdrawn.

With regard to claim 74 as currently amended, it requires a second section with at least one substantial planar surface. On the contrary, the "central portion" of the Barrows staple, which includes the "upper leg portion," is "a wire-like or hollow metal member". See column 2, lines 21-27. Therefore, at least one element of claim 74 is missing from Barrows and the rejection should be withdrawn. Since claim 75 depends upon claim 74, withdrawal of rejection to claim 75 is also respectfully requested.

Rejection of claims 5-8, 10, 12-15, 43-45, 47-49 under 35 U.S.C. §102(b) over U.S.  
Patent No. 5,366,479 (McGarry et al.)

First of all, with regard to claim 5 as currently amended, there is only one needle attached to the staple and the needle is substantially longer than any member of the staple (the pin, the base and the flange). With the McGarry staple, there needs to be two leg members with tapered tips in order for the staple pusher instrument to insert the staple into the tissues. None of these legs or the tips on such legs are substantially longer than the other member of the staple. Therefore, the structural elements of the McGarry staple is different from the inventive staple and the staple pusher instrument in McGarry is not constructed in a way so that it is inherently capable of articulating the inventive staple in the present Application. The "adapted to" language in the present Application is not merely a functional statement drawn to intended use. Rather, such "adapted to" language calls for substantially different construction of the staple holder which distinguishes the present invention from that in McGarry.

In light of the above discussion, withdrawal of the rejection to claim 5, as well as claims 6-8 and 10 which depend upon claim 5 is respectfully requested.

With regard to claim 12 as currently amended, the comments made above with regard to claim 5 are equally applicable here, therefore the rejection to claim 12 as well as claims 13-15 depending upon claim 12 should be withdrawn.

With regard to claim 44 as currently amended, once again, the claim calls for a single needle attached to the staple which is longer than either the first or the second section of the staple. The McGarry staple is different as discussed above with regard to claim 5 and the staple pusher instrument of McGarry is not constructed to articulate or close the inventive staple. Therefore, claim 44 as currently amended, along with the dependent claims 45-47 are allowable.

With regard to claim 48 as currently amended, the comments made above with regard to claim 5 are equally applicable. Therefore, rejection to claim 48 and claim 49 depending upon claim 48 should be withdrawn for the same reason.

Rejection of claims 11 and 18 under 35 U.S.C. §103(a) over U.S. Patent No. 5,366,479 (McGarry et al.)

As discussed above with regard to rejection to claim 5 under 35 U.S.C. §102(b) over McGarry et al., the construction of the inventive staple is substantially different from that in McGarry, resulting substantially difference applying instruments. With the teaching and suggestion of McGarry, one with ordinary skill in the art at the time of the present invention would not be able to construct an applying instrument which would work with the inventive staple consisting of a single needle which is substantially longer than the other construction members of the staple, let alone refining the dimensions of such instrument as defined in claims 11 and 18. Consequently, rejection to such claims should be withdrawn.

### CONCLUSION

No new matter is believed to have been added by the amendments. Further, Applicants believe that each matter of substance raised by the Examiner has been addressed. Also, in the

unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 388402000800. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: October 28, 1999

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